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Kazunori Kaneda

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

FISCHER, JUSTIN R

ART UNIT

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1747

NOTIFICATION DATE

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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PPROCESSING@SUGHRUE.COM
USPTO@SUGHRUE.COM

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Continuation of 7: The claims are rejected in the same manner as set forth in the Final Rejection mailed on August 26, 2010.

Continuation of 10: The declaration under 37 CFR 1.132 filed November 23, 2010 is insufficient to overcome the rejection of claims 1, 3-8, and 11 based upon Hahn as set forth in the last Office action because: the reference expressly teaches the use of resorcin (resorcinol). It is agreed that the reference suggests additional diols, such as hydroquinone; however, there is no picking and choosing when it comes to the diol since the primary reference (Hahn) expressly teaches a wire coat rubber composition including a polyester formed with resorcin. It is further noted that applicant's results and the original disclosure suggest that hydroquinone is a preferred embodiment and resorcinol is a most preferred embodiment. Thus, the declaration fails to provide a conclusive showing of unexpected results to establish a criticality for the claimed rubber composition.

Continuation of 11: Applicant argues that Hahn is directed to a high modulus rubber composition and fails to disclose or suggest improved adhesion between a coating rubber and a steel cord. However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). It is emphasized that the rubber composition of Hahn expressly includes a polyester formed by reacting a

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diacid chloride with resorcin and such is consistent with the claimed rubber composition.

Lastly, applicant's arguments with respect to the declaration have been addressed above.

/Justin R Fischer/

Primary Examiner, Art Unit 1747

November 29, 2010